



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/013,895 01/27/98 NI

J PF355

HM22/0818  
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EXAMINER

KAUFMAN, C

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

08/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Advisory Action**

Application No.

09/013,895

Examiner

Claire M. Kaufman

Applicant(s)

NI ET AL.

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 August 2000 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either a timely filed amendment which places the application in condition for allowance or a Notice of Appeal. Alternatively, applicant may obtain further examination by timely filing a request for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d).

**PERIOD FOR REPLY** [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136 (a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked.

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached "Continuation" sheets.

4. ☒ Applicant's reply has overcome the following rejection(s): See attached "Continuation" sheet.
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached "Continuation" sheet.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☐ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: \_\_\_\_\_
- Claim(s) withdrawn from consideration: \_\_\_\_\_
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☒ Other: Rejoinder-see attached "Continuation" sheets

Continuation of Disposition of Claims: Claims pending in the application are 22-33,35-51,53,55-70,72,75-81,84-89,91-105,108-114,118,120-124,126-141,144-152,156,158-161,165-173,176-195 and 198-219.

Allowed claims continued: 120-124, 126-129, 131-136, 138-141, 144-147, 149-152, 156, 158-161, 165-168, 170-173, 177-191, 193, 207, 209-213 and 215-219.

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## CONTINUATION of Paper #19:

3 continued. Claim 68 would remain rejected under 35 USC 112, first paragraph, for not being enabled for how to use a nucleic acid which is 90% identical to a nucleic acid encoding a relatively small fragment (25 amino acids) of SEQ ID NO:2, keeping in mind that the encoding nucleic acid does not need to have the sequence of the naturally occurring nucleic acid because of degeneracy of the genetic code. Proposed amended claim 89 would still be rejected under 35 USC 112, first paragraph, since the proposed amendment would not change the fact that the domain shown to be required for apoptosis in this specification and the prior art is only limited to that which is 90% identical to amino acids encoded by a nucleic acid encoding amino acids 265-468 of SEQ ID NO:2. Note that the way the proposed amendment is drawn, in the claim upon which 89 depends (claim 85), the first nucleic acid does not need to encode anything, let alone a polypeptide that allows for apoptosis to occur (see p. 5, lines 12-22, and p. 6, lines 20-28, of previous Office action of Paper #12). For proposed claim 101 changes, the claim would be confusing because it is not clear what the antecedent basis for "said first nucleic acid" is. If said first nucleic acid of claim 85 was intended, for example, the amendment should clearly indicate that.

4 continued. rejection under 35 USC 112, second paragraph, with the exception of claim 101 (see immediately above). Cancellation of rejected claims would moot rejections of the claims.

6 continued. For the rejection under 35 USC 112, first paragraph, beginning on page 8 of the previous Office action, lines 12-22 of that page (Paper #12), it is maintained that no Statement Concerning the Deposited cDNA Clone was in the application. Also, despite that fact that the letter head sheet accompanying this amendment filed 8/1/00 said a copy of the statement concerning deposited cDNA clone and copy of return postcard of 11/23/99 are enclosed with the this most recently filed amendment, no such documents could be found in the papers submitted.

For the response to the rejection under 35 USC 112, first paragraph, beginning on page 4 of the previous Office action, note that inclusion in the specification of methods for testing (see, e.g., p.

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20 of Applicants' response) in this instance provides an invitation to experiment without supportive information in the specification that provides a reasonable expectation of success without undue experimentation for the reasons discussed in the previous Office action.

5 Applicants' listing of claims rejected under 35 USC 112, first paragraph for the rejection found on p. 4 of the previous Office action appears to be correct. Applicants are correct that Form 392 incorrectly shows claim 34 as allowable and omits claim 67, which should have been indicated as rejected.

10 As to the rejection under 35 USC 102(a) on page 8 of the previous Office action, "Ns" do not indicate that there may be no nucleic acid there. It reasonably appears that there are nucleic acids, though the actual identity was not necessarily determined (for example, because of compression during sequencing). Also, the polynucleotide has a reading frame that would lead to encoding of amino acids as claimed, regardless of whether that reading frame was specified by  
15 the authors. Finally, in the absence of evidence to the contrary, it reasonably appears that the polynucleotide of Accession No. AA 100865 anticipates the claimed polynucleotide (non-obviousness is not at issue).

11 continued. While the request for rejoinder of claim 192 under *In re Ochiai* is proper, because  
20 prosecution is closed as the case is after final rejection, non-elected claims remain withdrawn from consideration. Rejoinder will be considered once all elected claims are in condition for allowance, the case is appealed and the appeal decided, or once prosecution is reopened, for example due to a CPA filed for the case.

25 *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Claire M. Kaufman, whose telephone number is (703) 305-5791. Dr. Kaufman can generally be reached Monday through Thursday from 8:30AM to 12:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
30 supervisor, Yvonne Eyler, can be reached at (703) 308-6564.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. NOTE: If applicant *does* submit a paper by fax, the original signed copy should be retained by the applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office. Please advise the examiner at the telephone number above before facsimile transmission.

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*cmk*  
cmk

August 16, 2000



LORRAINE SPECTOR  
PRIMARY EXAMINER